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09/982,274

10/17/2001

Ryan Lance Levin

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11/27/2006

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EXAMINER

COBANOGLU, DILEK B

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,274

Applicant(s)

LEVIN ET AL.

Examiner

Dilek B. Cobanoglu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the amendment received on 09/06/2006. Claim 1 has been amended. Claims 12-15 are newly added. Claims 1-15 are still pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being unpatentable by Douglas et al. (hereinafter Douglas) (U.S. Patent No. 6,039,688).

A. Claim 1 is amended to recite "offering the facilities and/or services to members of the medical scheme". The reasons for rejection of claim 1 has not been changed, it is rejected for the same reasons set forth in the previous Office Action (page 2). Applicant's arguments with respect to the aforementioned rejection are addressed below in the section entitled "Response to Argument".

B. Claims 2-11 have not been amended, they are rejected for the same reasons set forth in the previous Office Action (pages 2-5). Applicant's arguments with respect to the aforementioned rejection are addressed below in the section entitled "Response to Argument".

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C. As per newly added claim 13, Douglas discloses a method according to claim 1 wherein the provider of such medical scheme undertakes liability in return for a premium or contribution, and provides to members who pay such premiums or make such contributions, relevant health services and/or assistance in defraying expenses incurred in connection with rendering such relevant health services (Douglas; col. 5, lines 28-34, col. 19, lines 27-39 and Fig. 1).

D. As per newly added claim 14, Douglas discloses a method according to claim 13, including:

- i. The provider offering the facilities and/or services in conjunction with third party service providers (or case advisors) that provide health related facilities and/or services (Douglas; col. 5, lines 28-38);
- ii. Monitoring the use of the facilities and/or services by members by receiving information from the third party service providers (or case advisors) detailing the use of the health related facilities and/or services by the members (Douglas; col. 6, lines 2-6, Fig. 1).

E. As per newly added claim 15, Douglas discloses a method according to claim 14, wherein the members only pay a once off activation fee to gain access to the plurality of health related facilities and/or services (Douglas; col. 2, lines 9-22).

Examiner considers that the subscriber of this system would pay a activation fee to be a subscriber.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. (hereinafter Douglas) (U.S. Patent No. 6,039,688) in view of Ballantyne et al. (hereinafter Ballantyne) (U.S. Patent No. 5,867,821).

A. As per newly added claim 12, Douglas discloses the method according to claim 3:

Douglas fails to expressly teach the vaccination information. However, this feature is well known in the art, as evidenced by Ballantyne.

In particular, Ballantyne discloses vaccination information (Ballantyne; col. 15, lines 41-47).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Ballantyne with the motivation of enhancing healthcare quality (Ballantyne; col. 2, lines 55-62).

Response to Arguments

6. Applicant's arguments filed on 09/06/2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear.

A. In response to Applicant's argument about Douglas does not disclose the actual offering of health-related facilities and/or services to the individual, as is claimed in claims 1 and 11 of this application, Examiner respectfully submits that Douglas discloses health-related services for members of the medical scheme such as a service for losing weight or an online support group to help them achieve their health and wellness goals (Douglas; col. 5, line 65 to col. 6, line 6). As can be seen in Figure 1 and col. 5, lines 28-34, the patient's insurance (or the member's medical scheme) is part of this system.

B. In response to Applicant's argument about the Examiner did not give any reference in the office action for the recitation "the provider of such medical scheme undertake liability in return for a premium or contribution, and provides to members who pay such premiums or make such contributions, relevant health services, and/or assistance in defraying expenses incurred in connection with rendering such relevant health services" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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C. In response to Applicant's argument about Douglas does not disclose" the plurality of health-related facilities and/or services includes at least one of the group consisting of membership of health clubs, membership of gymnasiums, membership of fitness programs, weight-loss programs and programs to quit smoking", Examiner respectfully submits that Douglas reference disclose a service of weight-lost in col. 5, line 65 to col. 6, line 6. Therefore a case manager as a virtual coach can provide ongoing feedback and encouragement throughout the process.

D. In response to Applicant's argument about the Examiner did not give any reference in the office action for the recitation "managing the use of a medical scheme by members" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

E. In response to Applicant's argument about Douglas does not disclose "in any way advance authorization of hospitalization, advanced preauthorization of treatment, registration for electronic funds transfer and compliance with preferred procedures", Examiner would like to submit that the claim 6 states that

"predetermined procedures include at least one of the group consisting of advance pre-authorization of hospitalization, advance pre-authorization of treatment, registration for electronic funds transfer and compliance with preferred procedures". Douglas discloses "compliance with preferred procedures" in the abstract and col. 5, lines 28-34.

F. In response to Applicant's argument about Douglas does not disclose "reward allocated to the member is linked to the amount of the member's annual claims or whether or not the member has been hospitalized in a predetermined period of time", Examiner respectfully submits that in col. 14, lines 38-42, Douglas discloses rewards system and states that "user may earn points by reaching a certain milestone". Examiner interprets that one of the milestones can be a period of time whether or not the member has not been hospitalized or number of annual claims of the member, since the patients in the clinical group may be more likely to have more claims or hospitalized more often. (Douglas; col. 5, lines 45-51)

G. In response to Applicant's argument about Douglas does not disclose the limitation of claim 8, such that "the reward allocated to the member includes at least one of the group consisting of: prizes allocated on the basis of a draw, the magnitude of a member's credit value being related to the chance of winning the draw; access to health-related facilities and/or services for family members; decreased premium payments according to a predetermined scheme; and increased benefit payments according to a predetermined scheme", Examiner

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would like to submit that Douglas discloses the wellness group may further include family members of the clinical group who may need group support and/or counseling in dealing with the family member's chronic disease in col. 5, lines 52-59. Examiner considers that this is "giving access to family members to health-related facilities and/or services".

H. In response to Applicant's argument about Douglas does not disclose "the reward allocated to a member is not actually given to the member before a predetermined period has passed", Examiner would like to submit that Douglas discloses an example of a patient earn reward points for not smoking for 60 days. Claim 9 recites "a predetermined period", and Examiner interprets that "60 day" is a predetermined period. (Douglas; col. 18, line 66 –68)

I. In response to Applicant's argument about Douglas does not disclose "the reward allocated is forfeited by the member if they are not still a member of the medical aid scheme after the predetermined period has passed", Examiner would like to submit that Douglas teaches a system which subscribers (or patients), doctors, case advisors and health plan payor (such as HMO, insurance company), all provide input to and/or receive output from. (Douglas; col. 5, lines 28-34) As explained above in the rejection of claim 9, Douglas teaches "a predetermined period" to get the reward. Douglas also teaches personal rewards account, which users can earn rewards and keep them in this account, and then exchange for goods as explained in col. 14, lines 48-52. Douglas continues on col. 19, lines 49-65, the health payor views overall compliance status, perform

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case management review, perform an utilization review, review outcomes and communicates for eligible patients. Examiner considers that these can only be done if the patient or subscriber is still a member of the health payor (or medical aid scheme).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DBC
Art Unit 3626
11/17/2006


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SUPERVISORY PATENT EXAMINER